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EXAMINER

RONES, CHARLES

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 27

Application Number: 09/240,563
Filing Date: January 29, 1999
Appellant(s): BOOTHBY, DAVID J.

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For Appellant

EXAMINER'S ANSWER

MAILED

APR 05 2002

Technology Center 2100

This is in response to the appeal brief filed February 19, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Whether the judicially created obviousness-type double patenting rejection should require a terminal disclaimer to obviate the rejection as U.S. Patent and Trademark Office policy, statute 35 U.S.C. § 154 and case law requires.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,684,990

BOOTHBY

11-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22-27 are rejected under 35 U.S.C. § 154. This rejection is set forth in prior Office Action, Paper No. 22.

(11) Response to Argument

Appellant does not argue that claims 22 through 27 of the above-identified application are patentably distinct from claims 1, 6-7, 9, 17, 18, 19, 21 and 22 of U.S. Patent No. 5,684,990. Rather, appellant argues that the rationale giving rise to the judicially created doctrine of obviousness-type double patenting does not apply in this situation because any patent issuing on the above-identified application will necessarily expire prior to the expiration of U.S. Patent No. 5,684,990 (*i.e.*, that any patent issuing on the above-identified application will expire no later than January 11, 2015, twenty years from the January 11, 1995 filing date of the application which resulted in U.S. Patent No. 5,684,990). It is respectfully submitted that this argument is without merit because: (1) the judicially created doctrine of obviousness-type double patenting was not eliminated by either Congress or any Federal court due to the recent revisions of the patent term provisions of 35 U.S.C. §154; and (2) the rationale for the judicially created

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doctrine of obviousness-type double patenting remains notwithstanding the current patent term provisions of 35 U.S.C. § 154.

To comply with Article 33 of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement resulting from the Uruguay Round Agreements of the General Agreement on Tariffs and Trade (GATT), the United States was required to establish a minimum term for patent protection ending no earlier than twenty years from the date the application was filed. Article 33 of the TRIPS Agreement was implemented in the Uruguay Round Agreements Act (URAA) by an amendment to 35 U.S.C. § 154 to change the term of utility and plant patents from ending seventeen years from the date of patent grant to ending twenty years from the filing date of the application (or twenty years from the earliest filing date claimed under 35 U.S.C. §§ 120, 121, or 365(c)). See Pub. L. 103-465, § 532(a), 108 Stat. 4809, 4983-85 (1994). This change to 35 U.S.C. § 154 took effect on June 8, 1995, and applies to utility and plant applications filed on or after that date. See Pub. L. 103-465, § 534(b), 108 Stat. at 4990.

The amendments to 35 U.S.C. § 154 show that Congress intended to preserve the judicially created doctrine of obviousness-type double patenting. The patent term extension provisions of the URAA provide for an extension of patent term if the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability. See 35 U.S.C. § 154(b)(2) (1994 ed.) (amended 1999). This provision of the URAA contained a limitation that "[a]

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patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer **due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.**" See id (emphasis added).

Therefore, Congress expressly provided in the URAA's patent term extension provisions for the possibility of a terminal disclaimer filed in an original utility or plant application that was filed on or after June 8, 1995 due to the present of another patent claiming patentably indistinct subject matter (from that under review in the application under appeal) under the judicially created doctrine of obviousness-type double patenting.

Congress recently supplanted the patent term extension provisions of the URAA with the patent term adjustment provisions of the American Inventors Protection Act of 1999 (AIPA). See Pub. L. 106-113, § 4402, 113 Stat. 1501, 1501A-557 through 1501A-560 (1999). The patent term adjustment provisions of the AIPA also contain a limitation that "[n]o patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer." See 35 U.S.C. § 154(b)(2)(B) (Supp. V 1999). Therefore, Congress continues to provide in the patent term adjustment provisions of 35 U.S.C. § 154(b) for the possibility of a terminal disclaimer being filed in an original utility or plant application that was filed on or after June 8, 1995.

Congress could have eliminated the judicially created doctrine of obviousness-type double patenting when enacting the patent term provisions of the URAA if it wished to do so. Cf. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 28, 41 USPQ2d 1865, 1871 (1997) (noting that Congress may

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legislate the judicially created doctrine of equivalence out existence anytime it chooses, but concluding that the 1952 Patent Act, including enactment of 35 U.S.C. § 112, ¶6, did not, by negative implication, eliminate the doctrine of equivalence). There is, however, nothing in the legislation or legislative history of either the URAA or the AIPA that shows a legislative intent to eliminate the judicially created doctrine of obviousness-type double patenting. In addition, the patent term extension/adjustment provisions of the URAA and the AIPA each provide for the possibility of a terminal disclaimer being filed in an original utility or plant application that was filed on or after June 8, 1995. Therefore, Congress must have intended that the judicially created doctrine of obviousness-type double patenting to survive the patent term provisions of the URAA and the AIPA.

The Court of Appeals for the Federal Circuit (Federal Circuit) has rendered a number of decisions since June of 1995 that involved double patenting issues. See, e.g., Eli Lilly & Co. v. Barr Laboratories Inc., 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 52 USPQ2d 1590 (Fed. Cir. 1999); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Emert, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997); In re Lonardo, 119 F.3d 960, 43 USPQ2d 1262 (Fed. Cir. 1997); and Applied Materials v. Advanced Semiconductor Materials Am., 98 F.3d 1563, 40 USPQ2d 1481 (Fed. Cir. 1996). None of these decisions contains even an off-hand statement that the recent revisions of the patent term provisions of 35 U.S.C. § 154 has resulted in any impact on the judicially created

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doctrine of obviousness-type double patenting.¹ It is respectfully submitted that the Patent and Trademark Office should not assume that there has been such a fundamental change to the judicially created doctrine of obviousness-type double patenting in the absence of even a hint by the Federal Circuit that there actually has been such a change.

Moreover, the Patent and Trademark Office has recognized that there remain two reasons for continuing to insist upon a terminal disclaimer to overcome a judicially created double patenting rejection in an application subject to twenty-year term under 35 U.S.C. § 154(a)(2). See Terminal Disclaimers Required to Overcome Judicially Created Double Patenting Rejections in Utility and Plant Applications Filed on or After June 8, 1995, 1202 Off. Gaz. Pat. Office 112 (Sept. 30, 1997); see also MPEP 804.02.

The first reason for continuing to insist upon a terminal disclaimer to overcome a judicially created double patenting rejection is that the patent term provisions of 35 U.S.C. § 154(b) do not currently ensure that any patent issuing on a utility or plant application filed on or after June 8, 1995 will expire twenty years from the earliest filing date for which a benefit is claimed under 35 U.S.C. §§ 120, 121, or 365(c). As recently noted by the Federal Circuit: "the fundamental reason for the rule [of obviousness-type double patenting] is to prevent unjustified timewise extension of the right to exclude

¹ While none of these decisions involved an application (or patent resulting from an application) that was filed on or after June 8, 1995, the changes to the patent term provisions of 35 U.S.C. § 154 in the URAA has been the subject to a number of decisions by the Federal Circuit. See Abbott Lab. v. Novopharm Ltd., 104 F.3d 1305, 41 USPQ2d 1535 (Fed. Cir. 1997); Merck & Co., Inc. v. Kessler, 80 F.3d 1543, 38 USPQ2d 1347 (Fed. Cir. 1996); and Bristol-Myers Squibb Co. v. Royce Lab., Inc., 69 F.3d 1130 36 USPQ2d 1641 (Fed. Cir. 1995).

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granted by a patent no matter how the extension is brought about.” See Eli Lilly, 251 F.3d at 967-68, 58 USPQ2d at 1878 (quoting In re Van Ornum, 686 F.2d 937, 943-44, 214 USPQ 761, 766 (CCPA 1982), and In re Schneller, 397 F.2d 350, 354, 158 USPQ 210, 214 (CCPA 1968)). The patent term provisions of the URAA, however, provides for patent term extension (for patents resulting from applications filed on or after June 8, 1995 but before May 29, 2000), and the patent term provisions of the AIPA provides patent term adjustment (for patents resulting from applications filed on or after May 29, 2000), based upon prosecution delays during the application process. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56367 (Sept. 18, 2000), reprinted at 1239 Off. Gaz. Pat. Office 14, 14-15 (Oct. 3, 2000). Therefore, the Patent and Trademark Office must continue to insist upon a terminal disclaimer to overcome a judicially created double patenting rejection to avoid an unjustified timewise extension of patent term.

Since the above-identified application is a utility application filed on January 29, 1999, any patent issuing from the above-identified application would be entitled to patent term extension for the period of appellate review if the patent is issued pursuant to a decision reversing an adverse determination of patentability (*i.e.*, if appellant is successful in this appeal and a patent is issued as a result). See 35 U.S.C. § 154(b)(2) (1994 ed.). That is, if appellant were to prevail in this appeal, any patent issuing on the above-identified application would have a patent term extending beyond the expiration

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date of U.S. Patent No. 5,684,990.² Therefore, appellant's contention that any patent issuing on the above-identified application will necessarily expire prior to the expiration of U.S. Patent No. 5,684,990 is not correct.

The second reason for continuing to insist upon a terminal disclaimer to overcome a judicially created double patenting rejection is that 37 C.F.R. § 1.312(c)(3) requires that a terminal disclaimer filed to obviate a double patenting rejection include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. This requirement serves to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention (37 C.F.R. § 1.601(n)). See In re Van Ornum, 686 F.2d at 944-48, 214 USPQ at 767-70.³ Not insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in an application subject to twenty-year term under 35 U.S.C. § 154(a)(2) would result in the potential for the problem that 37 C.F.R. §1.312(c)(3) was promulgated to avoid.

² Absent an extension under 35 U.S.C. § 156, the term of U.S. Patent No. 5,684,990 will not extend beyond twenty years from its filing date (*i.e.*, beyond January 11, 2015) because: (1) that date is the longer of seventeen years from its date of grant or twenty years from its filing date (35 U.S.C. § 154(c)(1)); and (2) the patent term extension or adjustment provisions of 35 U.S.C. § 154(b) do not apply to U.S. Patent No. 5,684,990 as its filing date is prior to June 8, 1995.

³ Appellant states that the CCPA decision in Van Ornum is not binding on the Federal Circuit because Van Ornum was decided before the creation of the Federal Circuit. The Federal Circuit, however, has indicated that the decisions of the CCPA have been adopted as binding precedent. See In re Gosteli, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616-17 (Fed. Cir. 1989); and South Corp. v. United States, 690 F.2d 1368, 1369, 215 USPQ 657, 657 (Fed. Cir. 1982).

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Finally, it is brought to the attention of the Board of Patent Appeals and Interferences that arguments similar to those by appellant were raised during an appeal during the application for U.S. Patent No. 6,221,061 (ultimately issued after the filing of a terminal disclaimer). The Board of Patent Appeals and Interferences panel to which the appeal in that application was assigned rejected those arguments and sustained the judicially created double patenting rejection. See Ex parte Engelson, Appeal No. 1999-0610, slip op. at 5-8 (BPAI Nov. 16, 1999).⁴ Although Engelson is non-precedential and therefore not binding, it is respectfully submitted that the Board of Patent Appeals and Interferences should still be mindful of its prior decisions for consistency purposes. For the above reasons, it is believed that the rejections should be sustained.

⁴ This decision is designated as not written for publication and not binding precedent of the Board of Patent Appeals and Interferences. The decision, however, is available in the file of U.S. Patent No. 6,221,061, and is posted on the Freedom of Information Act (FOIA) page on the Patent and Trademark Office's Internet Web site.

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Respectfully submitted,

Charles L. Rones

Charles L. Rones
Patent Examiner
Art Unit 2175

April 3, 2002

Conferees met on April 2, 2002

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